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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,615	10/23/2003	Hideya Takakura	0951-0127P	5919
2292	7590	12/15/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			MATISIAK, JENNIFER E	
			ART UNIT	PAPER NUMBER
			2811	

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/690,615	TAKAKURA, HIDEYA	
	Examiner	Art Unit	
	Jennifer Matisiak	2811	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claim 2 is objected to because of the following informalities: The term "thickness" should be replaced with "width". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the limitation, "wherein either of the first or the second leads have their thickness reduced." The scope of the claim is vague because there is no frame of reference provided for having the thickness reduced. For the thickness to be reduced there must be some initial thickness, which is not discussed in the claims. Additionally, It is not known if this thickness is reduced from another portion of the second leads or if this is in reference to an attribute that is changed prior to completing the final structure.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Yasuda et al. (US 2003/0132512), hereinafter Yasuda.

Regarding claim 1, Yasuda discloses a lead frame (100a of Fig. 2b for example) to be used in a semiconductor device, which comprises a plurality of parallel first leads (12a of Fig. 2b) and a plurality of parallel second leads (13a of Fig. 2b), wherein the pitch of the first leads is different from that of the second leads, and the first leads are joined end-to-end with the second leads.

Regarding claim 2, Yasuda discloses a lead frame wherein at least either of the first leads or the second leads have their thickness, wherein "thickness" is taken to mean "width", reduced (13a of Fig. 2b).

Regarding claim 3, Yasuda discloses a method for manufacturing a semiconductor device using a lead frame, which comprises the steps of mounting a semiconductor element (not shown) on the lead frame (100a of Fig. 2b) and encapsulating the semiconductor element in a package (11a of Fig. 2b), wherein the dimension of the package for encapsulation is set such that at least either of the first leads or the second leads (13a of Fig. 2b) project from the package.

Regarding claim 4, Yasuda discloses a method for manufacturing a semiconductor device using a lead frame wherein at least either of the first leads or the second leads are squeezed by a mold for molding the package and have their thickness reduced (13a of Fig. 2b).

Since these claims depend on a device claim, they are considered product-by-process claims.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Therefore, no patentable weight is given to the product-by-process claim limitation because the device disclosed in the invention of Yasuda and the device of the instant invention are structurally equivalent.

Regarding claim 5, Yasuda discloses a semiconductor device using a lead frame (17 of Fig. 10, for example).

Regarding claim 6, Yasuda discloses electronic equipment using a semiconductor device (Fig. 10).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Matisiak whose telephone number is 571-272-2639. The examiner can normally be reached on Business Days 9:30a-6:30p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie Lee can be reached on 517-272-1732. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEM

Douglas W. Owens
Douglas W. Owens
Primary Examiner